

REMARKS

In the Office Action, the Examiner rejected claims 1-20. By this paper, Applicants have amended claims 1, 9, and 14 for clarification of certain features to expedite the allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1-20 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-20 under U.S.C. § 102(e) as anticipated by Zalewski et al. (U.S. Patent No. 6,647,508 B2). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Second, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (emphasis added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

Independent Claims 1 and 9 and Dependent Claims 2-8 and 10-13

Turning to the claims, independent claim 1 recites “allocating resources...wherein allocating resources comprises *cloning* a portion of the resources and allocating the original portion of the resources and a clone portion of the resources to different resource sets.” (Emphasis added). Independent claim 9, as amended, recites “dividing the resources... wherein dividing the resources comprises *cloning* a portion of the resources and allocating the original portion of the resources and the cloned portion of the resources to different subsets.” (Emphasis added). In contrast, the Zalewski reference discloses a

system in which “[p]artitions in the same community can share resources.” Col. 7, lines 41-42. Resources that are “shared by multiple partitions (for example, memory) will have handles that point to the community.” Col. 10, lines 29-31. The Zalewski reference makes no mention cloning resources. For this reason, the Zalewski reference cannot anticipate the features outlined above for independent claims 1 and 9. As such, Applicants respectfully request withdrawal of the Examiner’s rejections of claims 1-13.

Independent Claim 14 and Dependent Claims 15-20

Independent claim 14, as amended, recites “an *extensible firmware interface* comprising: a resource tabulator module...and a resource divider module.” (Emphasis added). In sharp contrast, the Zalewski reference does not even mention an extensible firmware interface. As such, the Zalewski reference cannot anticipate the features of independent claim 14 or the claims that depend from it. Accordingly, Applicants respectfully request withdrawal of Examiner’s rejections and allowance of claims 14-20.

Dependent Claims 2, 3, and 16

Claim 2 recites the method of claim 1 “wherein allocating resources comprises organizing the resources in a ROM-based environment.” Claim 3 recites the method of claim 2 “wherein organizing the resources in the ROM-based environment comprises gathering device data from a BIOS module.” Claim 16 recites the system of claim 15 “wherein the resource tabulator module and the resource divider module are disposed in ROM.” In rejecting each of these claims, the Examiner relied on a theory of inherency. *See* Office Action, page 4 and page 6. For example, in rejecting claim 3, the Examiner stated that it is “inherent to the system as a BIOS contains the important device data.” *Id.* In response to these rejections, Applicants traverse and remind the Examiner that if the Examiner believes that limitations are inherent in a cited reference, the Examiner “*must provide some evidence or scientific reasoning* to establish the reasonableness of the Examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex part Skinner*, 2 U.S.P.Q. 2 d 1788 1789 (Bd. Pat App. & Inter. 1986) (emphasis

Serial No. 10/023,680
Response to Office Action
Mailed October 5, 2004

added). Applicants respectfully assert that the features of claims 2, 3, and 16 are not inherent and stress that the Examiner has not provided evidence or scientific reasoning to support the Examiner's assertion of inherency. For this reason, in addition to the reasons outlined above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 to claims 2, 3, and 16.

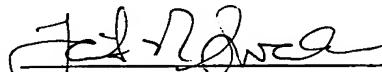
Conclusion

Applicants respectfully remind the Examiner that the Zalewski reference (cited under 35 USC 102(e)) *would not qualify* as prior art under 35 U.S.C. § 103(a). Specifically, Applicants respectfully stress that the Zalewski reference, if applied under section 103(a), would be removable in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and the Zalewski reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to Compaq Information Technologies Group L.P., now a wholly owned affiliate of Hewlett Packard Company.

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: January 3, 2005



Tait R. Swanson
Registration No. 48,226
(281) 970-4545

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400